

REMARKS

Claims 1-15 are pending in the application.

Claim Rejections

35 USC § 101

Claims 1-15

The Examiner has rejected claims 1-15 under 35 USC 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

In making this rejection the Examiner has cited the USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (USPTO Official Gazette Notices, 22 November 2005; hereinafter "Interim Guidelines") as supporting the Examiner's assertion that the pending claims fail to include "practical application, result, concrete, useful and tangible" limitations (Office Action of April 12, page 3; hereinafter the "Office Action"). However, Applicants respectfully assert that the Examiner has failed to maintain the USPTO's burden to set forth a *prima facie* case of unpatentability based on non-statutory subject matter.

The requirements incumbent on the Examiner for establishing a *prima facie* case of unpatentability based on non-statutory subject matter are set forth, in detail, in the cited Interim Guidelines. Firstly,

(t)o properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. § 101, USPTO personnel **must** first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or compositions of matter). (Interim Guidelines; pp. 14-15, emphasis added).

As the Interim Guidelines further point out, the

subject matter (that) courts have found to be outside of, or exceptions to, the four statutory categories of invention is **limited** to abstract ideas, laws of nature and natural phenomena. (Interim Guidelines; p. 13, emphasis added).

Ultimately, the

burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner **must provide an explanation**. (Interim Guidelines; p. 16, emphasis added).

The Applicants respectfully point out that in the making the rejection at issue the Examiner has simply stated that the claimed subject matter is non-statutory but has not provided an explanation of how or why the claimed subject matter falls outside of the statutory categories. Moreover, as the Interim Guidelines clearly state, if the Examiner believes the claimed subject matter falls outside the four statutory categories then the Examiner must classify the claimed subject matter within one of the three exceptions to the four statutory categories: namely abstract ideas, laws of nature or natural phenomena.

Therefore, Applicants assert that if, for example, the Examiner believes that the claimed subject matter is not a process within the meaning of 35 U.S.C. § 101 then the Examiner should explain why the Examiner believes so. As noted above, if the Examiner believes that the claimed subject matter is not a statutory inventive process within the meaning of 35 U.S.C. § 101 then the Examiner must, according to the Interim Guidelines, classify the claimed subject matter within one of the limited exceptions of an abstract idea, a law of nature or a natural phenomena.

Applicant respectfully points out that the Examiner has already rejected, in the previous Office Action of September 1, 2005 (hereinafter the "Previous Office Action"), pending claims 1-5 under 35 U.S.C. § 101 arguing that the claimed subject matter fell within the realm of an

abstract idea. In reply to this Previous Office Action, Applicants asserted that the claimed subject matter is not directed to an abstract idea but, is, rather, directed to statutory subject matter. Specifically, Applicants drew the Examiner's attention to the recited limitation of "a plurality of search engines" and that portion of the Application wherein the term "search engine" is explained as encompassing "any *technology* capable of searching for information according to a received query." (Application; page 4, lines 13-15; emphasis added). The Examiner clearly acceded to the Applicants arguments regarding this previous subject matter rejection by stating in the current Office Action that "(i)n response to Applicants remarks, all previous presented rejections of the claims are hereby withdrawn as to being moot." (Office Action; p. 2).

The Examiner has failed to provide either an explanation of the current subject matter rejection in keeping with the Interim Guidelines, or an explanation of why, if Applicants arguments in reply to the subject matter rejection of claims 1-5 were persuasive when provided to the Examiner in response to the Previous Office Action, those arguments are now, suddenly, no longer persuasive. Applicants believe that the Examiner should explain these inconsistencies.

If, for the sake of argument, Applicants take the current subject matter rejection of claims 1-15 at face value, i.e., if Applicants assume that the Examiner has made a *prima facie* case for subject matter unpatentability, which, nonetheless, Applicants believe the Examiner has failed to do, then Applicants offer the following arguments in response to the Examiners assertion that claims 1-15 fail to be "directed towards the final result that is 'useful, tangible and concrete,'" (Office Action, p. 2). While the following arguments are directed to independent claim 1, the other independent claims 6 and 11 recite similar limitations.

As noted above (and as argued in reply to the Previous Office Action), Applicants respectfully draw the Examiner's attention to the recited limitation in claim 1 of "a plurality of search engines" and to that portion of the Application wherein the term "search engine" is

explained as encompassing “any *technology* capable of searching for information according to a received query.” (Application; page 4, lines 13-15; emphasis added). Applicants assert that such a limitation is clearly tangible and concrete. The Examiner’s previous acquiescence to this argument appears to support Applicants assertion.

Further, with regard to the claimed subject matter being “useful,” Applicants respectfully draw the Examiner’s attention to the recited limitation in claim 1 of “identifying, according to properties returned by a plurality of search engines, at least one search engine suited to service a query.” Applicants assert that, identifying, from a plurality of search engines, one search engine suited to service a query is clearly a useful final result.

Thus, in conclusion, Applicants respectfully assert that the Examiner has failed to establish a *prima facie* rejection under 35 U.S.C. § 101 and it is therefore respectfully requested that the Examiner withdraw her rejection of claims 1-15.

Application No. 09/752,799
Reply to Office Action of April 12, 2006
Attorney Docket: 42390.P10833

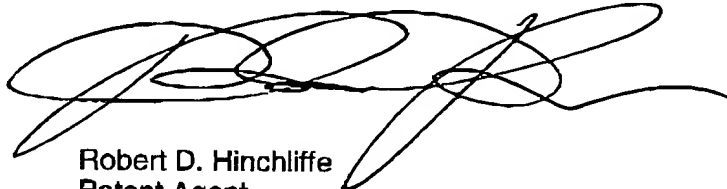
CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner has any questions, she is invited to contact the undersigned at (503) 264-6473. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,



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Dated: May 15, 2006

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